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09/982,365	10/17/2001	Bradley P. Lane	LANEB.55838	7814

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,365

Applicant(s)

LANE, BRADLEY P.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) 2-15, 17 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1, 16, 18-23, 26-33, 35 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 24 and 25 have been canceled. Claims 1, 16, 18-23 and 26-33 have been amended for further examination.

Election/Restriction

After further examination upon applicants request to reconsider Claims 35 and 36 as part of the elected invention, the examiner has included claims 35 and 36 in the elected invention of Group II, which now consist of Claims 1, 16, 18-23, 26-33, 35 and 36.

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Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "106" has been used to designate both a "gutter section" and "weld lines", as stated in page 10 of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Liener Chin et al (6,632,042).

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Liener Chin et al discloses in Fig. 21-23, a method for organizing comprising: providing a looseleaf page for a display album (Fig. 21) having storage sleeves forming pockets (910 in Fig. 23) with an opening (A) along one side (A1), a viewing window (910A) for viewing a collectible materials; wherein the pocket has indicia (written in 920); and wherein a display item is placed in the pocket; generating and attaching a table of contents (890 in Fig. 22) to the display album including a listing of material descriptors (884); assigning positional identifiers (854).

In regards to the pocket indicia matching the positional identifier so that a user may determine the location of collectible materials, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The pocket indicia of Liener Chin et al is capable of disclosing indicia matching positional identifiers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al (6,632,042) in view of Staar (5,136,562) and further in view of Vineyard et al (6,265,043).

Liener Chin et al discloses in Fig. 21-23, a method for organizing comprising: providing a looseleaf page for a display album (Fig. 21) having storage sleeves forming pockets (910 in Fig. 23) with an opening (A) along one side (A1), a viewing window (910A) for viewing a display item; wherein the pocket has indicia (written in 920); and wherein a display item is placed in the pocket.

However, Liener Chin et al does not disclose: selection of a plurality of compact discs, each disc having a title and a liner; wherein the compact discs are to be organized in the slots of a compact disc changer placed in the respective slots.

Vineyard et al et al discloses in Fig. 1, a compact disc (A) having a title (30) and a liner (28) with printed indicia.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method of organizing organizer to include a compact disc as a display item having a title and a liner with printed indicia as taught by Vineyard et al et al for the purpose of displaying a labeled compact disc.

However, Liener et al as modified by Vineyard et al do not disclose wherein the compact discs are to be organized in the slots of a compact disc changer placed in the respective slots.

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Staar discloses in Fig. 1-3, a plurality of compact discs organized and placed in the slots (24) of a compact disc changer, wherein the slots have a slot identifier (20 in Fig. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's and Vineyard et al's method of organizing with compact discs as display items which can be stored and identified in a disc changer as taught by Staar for the purpose of providing compact discs which can be placed in a CD changer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia on the CD, pocket, and slot, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Therefore, the indicia associated with the liner in the Vineyard et al reference can recite any information desired by the end user. Furthermore, in regards to the pocket indicia matching the respective slot identifier so that a user may determine the location of compact discs, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The pocket indicia of Lien Chin et al is capable of disclosing indicia matching slot identifiers.

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5. Claim 16, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al.

Liener Chin et al discloses Fig. 21-23, a method of organizing comprising: a binder (830) having a plurality of sheets (750 and 820) having transparent windows; a pre-established list of titles (884); index identifiers (854 in Fig. 22) which are placed next to a respective title (as shown in Fig. 22); a selection of position identifiers (894 on tab 898) which are placed on the pocket (as shown in Fig. 22); wherein visual display (which can be any desired display (Col. 1, lines 5-10) may be placed in the respective pockets (as seen in Fig. 23).

However, Liener Chin et al does not disclose: selection of identifiable entertainment recordings; titles of entertainment recordings.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of indicia on the list such as a list of entertainment recordings, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The list of Liener Chin et al is capable of listing entertainment recording titles.

6. Claims 18-31 and 33, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Gustafson (3,645,637) and further in view of Brosmith et al (5,692,607).

Liener Chin et al discloses in Fig. 21-23, a display apparatus comprising: an elongated spine member (830A); a first cover member (830B); a second cover member (830C); hinge sections (830D) to connect the cover members to the spine; a plurality of looseleaf pages (820) having storage sleeves forming pockets (910 in Fig. 23) with an opening (a) along one side (A1), a viewing window (910A) for viewing a display item; and wherein the pockets can be either a 1x1 matrix or a 2x2 matrix (as seen in Fig. 24 and 25); a perforated hinge section (820A); wherein the pocket has indicia (written in 920); and wherein a display item is placed in the pocket; and a plurality of detachable post members (830E); and wherein one of the pages displays a table contents (750 in Fig. 21).

However, Liener Chin et al does not disclose: a spine member having an upper flange and lower flange folded to form an upper and lower rearwardly facing retention recess; a first and second cover member wherein each has an inner most end having a first and second flexible hook for insertion into the upper and lower retention recess from a spine direction; wherein the hooks

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cooperate with the flanges to pivotally attach the cover members to the spine; pages having a gutter section positioned between a display section and a perforated hinge section with at least one pocket having a non-woven backing and an opposing transparent viewing section; post members projecting between the upper and lower flange for securing the cover members to the spine, whereby the post may be disconnected to releasably secure the pages between the cover members.

Gustafson discloses in Fig. 1, 15 and 16, a display apparatus comprising: an elongated spine member (24) having an upper flange and lower flange (portion of (81 and 83)) folded to form an upper and lower retention recess (space between flange and sheets (23) as shown in Fig 16); a first cover member (21) and a second cover member having a flexible hook (62) for insertion into the upper and lower recesses, wherein the hooks cooperate with the flanges to pivotally attach the cover members; a plurality of detachable posts (44) for securing the first and second covers and further for passing through a perforated hinge section of the attached loose leaf pages, wherein the post ends are covered by a folded flange flap (as seen in Fig. 13).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's display apparatus with a spine member, cover members, post members as taught by Gustafson for the purpose of providing an alternative means in which to hold and secure display pages.

However, Liener Chin et al as modified by Gustafson do not disclose looseleaf pages comprising: a gutter section positioned between the perforated hinge section and the display

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section, wherein the display section has at least one pocket with a non-woven backing, a common divider, an opposing transparent window; a 2x2 pocket matrix; a 2x1 pocket matrix with pages being 7 and 7/8 inches wide and 10 and 7/8 inches tall; a 1x1 pocket matrix with pages being 7 and 7/8 inches wide and 6 inches tall; a thumb notch; post formed in 1/4 inches detachable sections; pockets are 5 inches wide by 5 inches high and 2.5 inches to 3 inches square; and the gutter section is 1 inch wide.

Brosmith et al discloses in Fig. 1-4, a looseleaf pages comprising a well section (a) positioned between the hinge section (22) and the display section (12, 14, 16), wherein the display section has a pocket with a non-woven backing (14), a common divider (Fig. 1, which consist of backing (14)), and an opposing transparent window (12 and 16); and a thumb notch (38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's and Gustafson's display apparatus to include looseleaf pages having a gutter section, a display section having a pocket, and a hinge section as taught by Brosmith et al for holding discs in a binder.

In regards to **Claim 18 and 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the opening of the pocket, the facing direction of the upper and lower retention recess at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 26**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to divide the post into detachable sections, since it has been

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held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In regards to **Claims 20, 21, 29, 30 and 33**, it would have been an obvious matter of design choice to construct the pages, pockets and gutter section in any desired size, since such a modification would have involved a mere change in the size of a component. a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Therefore the pages, pockets and gutter section can be constructed in any size to accommodate any sized display item.

7. Claim 32 as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al as modified by Gustafson and Brosmith et al, and further in view of Ho (5,501,540).

Liener Chin et al as modified by Gustafson and Brosmith et al discloses a display apparatus comprising all the elements as claimed in Claim 18. However, Liener Chin et al does not disclose a display apparatus comprising: table of contents listing all compact disc titles; liner notes stored in pockets; and wherein the listing links each of the titles to a position of each compact disc in the changer.

Ho discloses a pocket (34) comprising a liner note (341) stored in the pocket.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's display apparatus with a liner note stored in

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a page pocket as taught by Ho for the purpose of holding more information correlated to the display item.

In regards to **Claim 32** wherein the table of contents links each of the titles to a position in the CD changer, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The table of contents listing of Liener Chin et al is capable of linking each title to a position in the CD changer.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Vinyard et al, and further in view of Bakke et al.

Liener Chin et al discloses a method of organizing comprising all the elements as claimed in Claim 35, and as set forth above. However, Liener Chin et al does not disclose a first set of stickers which are placed on a respective pocket; and a second set of stickers placed on the collectible item.

Vinyard et al discloses stickers which can be placed on a collectible items such as a compact disc.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method for organizing with a label on a

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collectible item such as a compact disc as taught by Vinyard et al for the purpose of describing the contents of the collectible item.

However, Liener Chin et al as modified by Vinyard does not disclose a sticker placed on a pocket.

Ho discloses in Fig. 1 and 7, a label (104) placed in a pocket which is placed on top of a storage pocket (48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method of organizing by providing a label placed and secured on a pocket as taught by Bakke et al for the purpose of labeling the pockets contents.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a pocket or sleeve in place of adhesive, since the examiner takes Official Notice of the equivalence of securing a label substrate by placing it in a pocket or sleeve to that of having adhesive placed on the substrates backside to secure it to an item, and the selection of any of these known equivalents to secure an item would be within the level of ordinary skill in the art.

Furthermore, in regards to the stickers of the second set to correspond to the stickers of the first set, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re*

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Otto, 136 USPQ 458, 459 (CCPA 1963). Therefore, the stickers from Bakke et al and Vinyard et al are capable of corresponding with each other.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Condorodis, Palmer et al, Price et al, Bergh et al, Otake et al, Otake et al ('039), Wilkins, Brotschi, Hoopingarner, Oshry et al, Ranalli, Tapper, and Stenger disclose a method and display apparatus for organizing collectible items.

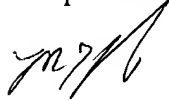
Response to Arguments

9. Applicant's arguments with respect to claims 1, 16, 18-23, 26-33, 35 and 36 have been considered but are moot in view of the new ground(s) of rejection.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 16, 2003



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